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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,769

Applicant(s)

OSCAR ET AL.

Examiner

Rachel L. Porter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 19-22, 32-35 and 40-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-18, 23-31 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/20/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the election filed 8/4/05. Claims 1-48 are currently pending. Claims 1-13, 19-22, 32-35, and 40-48 are withdrawn from further consideration as per applicant's response to the restriction requirement.

Election/Restrictions

2. Restriction to one of the following inventions was required under 35 U.S.C. 121:
- I. Claims 1-13 and 40-48, drawn to a general pharmaceutical management system, classified in class 705, subclass 2.***
 - II. Claims 14-18, 23-31 and 36-39, drawn to downloading benefit information, classified in class 705, subclass 2.
 - III. Claims 19-20 and 32-33, drawn to patient input verification, classified in class 705, subclass 3.
 - IV. Claims 21-22 and 34-35, drawn to database querying, classified in class 707, subclass 3.

Applicant's election with traverse of Group II in the reply filed on 8/4/05 is acknowledged. The traversal is on the ground(s) that Group I (Claims 1-13 and 40-48) and Group II (claims 14-18, 23-31 and 36-39) are classified together and therefore there is not burden on the examiner to search both groups. This is not found persuasive because Inventions I and II were found to be related to one another as combination and subcombination respectively. Inventions in this relationship are distinct if it can be

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shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the all of the details of downloading and updating of information required in the subcombination. Moreover, a restriction among two inventions that are classifiable together is still proper when the inventions have acquired a separate status in the art because of their recognized divergent subject matter. Because the details of the subcombination are not required for the combination, the Examiner submits that there is divergent subject matter between the two inventions. Thus, the requirement is still deemed proper and is therefore made FINAL.

*****NOTE:** It is noted that in the original restriction requirement mailed 7/5/05, dependent claim 13 was unintentionally omitted from a claim grouping. Claim 13 should have been included in Group I. In a telephone conversation conducted on 10/14/05 between Examiner Porter and Mr. John F. Guay, Reg. No. 47,248, Mr. Guay agreed that it was not necessary for the Examiner to send another restriction requirement to simply to include claim 13 in the Group I listing. However, Mr. Guay requested that the Examiner state the correct claim groupings in the present Office Action. This has been provided in paragraph 2 of the present Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14-18, 23-31 and 36-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites “means for downloading information from a processor....” It is unclear to the examiner if the downloaded information is the same as the claim information or if the downloaded information a separate type of information. As it is currently worded, “the claim information” seems to modify the information the data on the processor server. Claims 14-18 and 23-26 inherit the deficiencies of claim 14 through dependency and are also rejected.

Also, as per claims 13-18 and 23-24, it is unclear how the wherein clauses are intended to modify the structure of the system/apparatus claims. In other words, it is unclear, it is unclear whether the clauses describe additional elements of the server which actually have some functionality or if they are only intended to describe the information stored/downloaded. (i.e. non-functional data)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14-18, 23-31 are rejected under 35 U.S.C. 103(a) as being obvious over Pack-Harris (USPN 6,195,612) in view of Mayaud (USPN 5,845,255)

[claim 14] Pack-Harris discloses a pharmacy benefits management server comprising:

- means for downloading information from a processor server having claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients; (Figure 1, col. 3, lines 55-col. 4, line 4; col. 4, lines 14-26)
- means for downloading pharmacy benefits plan structure information stored therein; (col. 4, lines 27-32)
- means for downloading price information relating to drugs in various classes stored therein; and (Figure 18-19)
- means for correlating the claim information with the benefits plan structure information, the price information, and, alternative drugs in the same class as the selected drugs, and expenses associated with the alternative drugs. (Figure 3, Fig. 5, col. 35-59)

Pack-Harris discloses the system as disclosed above, but does not expressly disclose providing pharmacy benefits formulary information. Mayaud discloses a method wherein pharmacy benefits formulary information is transmitting and provided in a pharmacy system. (col. 13, lines 49-61; col. 14, lines 10-19) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to

modify the system of Pack-Harris with the teaching of Mayaud to provide/transmit formulary benefits data in a pharmacy system. As suggested by Mayaud, one would have been motivated to include this feature to encourage better formulary prescription compliance and reduce health-care costs. (col. 13, lines 49-61)

[claims 15] Pack-Harris discloses a server as recited in claim 14, wherein the selected drugs are drugs previously dispensed to a patient. (Figures 8 and 32; col. 6, lines 37-54)

[claim 16] Pack-Harris discloses a server as recited in claim 14, wherein the alternative drugs are therapeutic alternatives with respect to the selected drugs. (Figure 3, Figure 4 (brand vs. generic reports, col. 5, lines 35-45))

[claim 17] Pack-Harris discloses a server wherein the benefits plan structure information (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives)) and the formulary information relate to a multi-tier benefits plan.

[claim 18] Pack-Harris discloses a server as recited in claim wherein the expenses associated and the expenses associated with the alternative drugs includes copayment information and total cost information. (col. 5, lines 35-59; Figure 33)

[claim 23] Pack Harris discloses a server wherein the alternative drugs are therapeutic alternatives with respect to the selected drugs. (Figure 3, Figure 4 (brand vs. generic reports, col. 5, lines 35-45))

[claim 24] Pack –Harris discloses a server, wherein the benefits plan structure information and the formulary information relate to a multi-tier benefits plan. (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives))

[claim 25] Pack-Harris discloses a server as recited in claim 14 further comprising means for entering proposed changes to any of the claim information, the benefit plan structure information, and the formulary information and displaying model data based on the proposed changes. (Figure 1; col. 3, lines 10-45; lines 55-col. 7, line 4)

[claim 26] Pack-Harris discloses a server as recited in claim 25, wherein the proposed changes comprise any of changes to copayment amounts, changes to copayment levels, and changes drugs dispensed. (col. 4, lines 33-67)

[claim 27] Pack-Harris teaches a pharmacy benefits management method comprising the steps of.

- downloading claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients; (Figure 1, col. 3, lines 55-col. 4, line 4; col. 4, lines 14-26)
- downloading pharmacy benefits plan structure information; (col. 4, lines 27-32)
- downloading price information relating to drugs in various classes; and (Figure 18-19)

- correlating the claim information with the benefits plan structure information, the price information to identify drugs expenses associated with selected drugs in accordance with the pharmacy benefits plan structure information, alternative drugs in the same class as the selected drugs, and expenses associated with the alternative drugs. (Figure 3, Fig. 5, col. 35-59)

Pack-Harris discloses the method as disclosed above, but does not expressly disclose providing pharmacy benefits formulary information. Mayaud discloses a method wherein pharmacy benefits formulary information is transmitting and provided in a pharmacy system. (col. 13, lines 49-61; col. 14, lines 10-19) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Pack-Harris with the teaching of Mayaud to provide/transmit formulary benefits data in a pharmacy system. As suggested by Mayaud, one would have been motivated to include this feature to encourage better formulary prescription compliance and reduce health-care costs. (col. 13, lines 49-61)

[claim 28] Pack-Harris teaches a method wherein the selected drugs in said correlating step are drugs previously dispensed to a patient (Figures 8 and 32; col. 6, lines 37-54)

[claim 29] Pack-Harris teaches a method, wherein the alternative drugs in said correlating step are therapeutic alternatives with respect to the selected drugs. (Figure 4 (brand vs. generic))

[claim 30] Pack-Harris and Mayaud in combination teach a method wherein the benefits plan structure information and the formulary information relate to a multi-tier benefits plan. (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives))

[claim 31] Pack-Harris teaches a method as recited in claim 30, wherein the expenses associated and the expenses associated with the alternative drugs includes copayment information and total cost information. (col. 5, lines 35-59; Figure 33)

[claim 36] Pack-Harris teaches a method, wherein the alternative drugs are therapeutic alternatives with respect to the selected drugs. (Figure 3, Figure 4 (brand vs. generic reports, col. 5, lines 35-45))

[claim 37] Pack-Harris and Mayaud in combination disclose a method, wherein the benefits plan structure information and the formulary information relate to a multi-tier benefits plan. (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives))

[claim 38] Pack-Harris and Mayaud in combination disclose a method further comprising the step of permitting entry of proposed changes to any of the claim information, the benefit plan structure information, and the formulary information; (col. 3, line 55-col. 4, line 67) and displaying model data based on the proposed changes. (Figure 3, col. 5, lines 35-67)

[claim 39] The limitations of claim 39 are addressed by the rejection of claims 26 and 38.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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